

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed March 17, 2009. At the time of the Office Action, Claims 1, 3-5, 8, 10-12, 14-16 and 18-23 were pending in the Application and stand rejected. Applicant amends several Independent Claims without prejudice or disclaimer. The amendments to these claims are not the result of any Prior Art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 102 Rejection

The Examiner rejects Claims 1-5, 7-12 and 14-23 under 35 U.S.C § 102(b) as being anticipated by U.S. Publication No. 2002/0129140 issued to Peled et al (hereinafter "*Peled*").

*Independent Claim 1 is Patentable over Peled*

Applicant respectfully reminds the Examiner that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.<sup>1</sup> In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim."<sup>2</sup> In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."<sup>3</sup> Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support

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<sup>1</sup> *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

<sup>2</sup> *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*).

<sup>3</sup> MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*)).

the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.<sup>4</sup>

Independent Claim 1, as amended, recites (inter alia) “...*wherein the user is alerted if an attempt to transmit the registered document over a network is made, whereby an alert mechanism is configured by the user during the requested registration of the registered document.*” In the recent Office Action, the Examiner explains:

6. As per claim 4, Peled discloses the method of claim 3. Peled further discloses alarming the user that requested registration of the registered document in response to detecting the registered content (Peled: [0092]: taking enforcement action).

However, Paragraph 0092 explains:

**[0092]** a signature extractor, associated with the transport data monitor, for extracting a derivation of payload of the monitored data, the derivation being indicative of content of the data,

These two items are obviously inconsistent, and Applicant presumes this to be an Examiner error. No reference of record offers the alerting mechanism outlined by Independent Claim 1: much less an alert that is configured by the user during document registration, as outlined by Independent Claim 1.

Secondly, for the ‘intercepting’ and ‘reassembling’ elements of Independent Claim 1, the Examiner cites Paragraph 055, which discloses:

**[0055]** Preferably, the network is a packet network, and a buffer is associated with the signature extractor to enable the signature extractor to extract a signature from a buffered batch of packets.

Clearly, this does not provide the requisite intercepting and reassembling operations, as outlined in Independent Claim 1. Finally, no reference of record, including *Peled*, offers an architecture in which “...each signature being associated with one of a

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<sup>4</sup> MPEP §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis in original*)).

plurality of registered documents...each registered document is associated with a user that requested registration of the document.” For this limitation, the Examiner has cited the following portion of *Peled*:

[0019] a database of at least one preobtained description of content whose movements it is desired to monitor, and

There is no disclosure about each registered document being associated with a specific user that requested registration of the document. Specifically, Independent Claim 1 is outlining that each registered document has a counterpart; namely, the user that requested registration of that specific document. In contrast, there is no user specified in *Peled*; much less one that requested the registration, as is outlined by Independent Claim 1. At best (and Applicant is simply hypothesizing about how *Peled* might work in a fictional sense), there is a single user that would somehow configure the architecture. In no event does *Peled* disclose a user requesting registration of the document and that document having an association with that specific user, who requested the registration. Applicant has taken the time to review *Peled* in its entirety and finds nothing that would be relevant to this feature of Independent Claim 1.

For at least these reasons, Independent Claims are allowable over the cited reference. Additionally, the corresponding dependent claims from these Independent Claims are also patentably distinct for analogous reasons.

#### Section 103 Rejection

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Peled* in view of U.S. Publication No. 2003/0084300 issued to Koike (hereinafter “*Koike*”). This rejection is now moot in light of the preceding §102 analysis. Specifically, nothing in *Peled* (or in any other reference) provides the features evaluated extensively above.

For at least these reasons, all of the pending claims have been shown to be allowable as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. However, please apply any other charges or credit any overpayment to Deposit Account No. 50-4889 of PATENT CAPITAL GROUP, referencing the attorney docket number referenced above.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas J. Frame at (214) 823-1241.

Respectfully submitted,  
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